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33 UNITED STATES DISTRICT COURT
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35 NORTHERN DISTRICT OF CALIFORNIA
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37 INVITAE CORPORATION,
38 Plaintiff,
39 v.
40 OPTRAHEALTH, INC.,
41 Defendant.
42

43 Case No. 4:22-CV-00784-HSG

44 **JOINT CASE MANAGEMENT
45 STATEMENT & [PROPOSED] ORDER**

1 The parties to the above-entitled action jointly submit this JOINT CASE
 2 MANAGEMENT STATEMENT & PROPOSED ORDER pursuant to the Standing Order for All
 3 Judges of the Northern District of California and Civil Local Rule 16-9.

4

5 **1. JURISDICTION & SERVICE**

6 This is an action for declaratory judgment arising under 28 U.S.C. §§ 2201 and
 7 2202, and the United States Patent Act, 35 U.S.C. § 1 *et seq.* The Court has subject matter
 8 jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202.

9 **2. FACTS**

10 **Plaintiff's Statement:**

11 Invitae is a leading medical genetics company in the business of delivering genetic testing
 12 services that support a lifetime of patient care. One of Invitae's successful products is its Genetic
 13 Information Assistant or Gia® ("Gia"). The Gia software is a HIPAA-compliant clinical chatbot
 14 that facilitates virtual conversations with patients, including intake of family history and automatic
 15 delivery of results. Gia is designed by genetic experts and is used by more than 100,000 patients
 16 and their doctors.

17 OptraHealth sent a letter to Invitae alleging that Gia infringes the '882 Patent on August 30,
 18 2021. OptraHealth's letter contends that "the functionality provided in GIA . . . infringes on the
 19 claims granted to OptraHEALTH in Patent '882" and specifically identifies claim 1 of the '882
 20 Patent as being infringed. Moreover, OptraHealth's letter demands that Invitae immediately cease
 21 and desist infringement of the '882 Patent.

22 Invitae thoroughly refuted Optra Health's baseless infringement allegation in a letter dated
 23 September 30, 2021. After further correspondence, including threats to at least one Invitae
 24 customer, OptraHealth warned Invitae, in a letter dated November 10, 2021, that it was providing
 25 "a last opportunity to resolve the issues" and attached a draft compliant alleging infringement of
 26 the '882 Patent.

27 Faced with these ongoing, persistent, and baseless threats of lawsuits against Invitae and its
 28 customers for patent infringement — and for a product developed prior to the filing of

1 OptraHealth's patent application — Invitae has no choice but to file this action in order to resolve
 2 this dispute.

3 OptraHealth has not asserted any counterclaims against Invitae in this action. Instead,
 4 OptraHealth followed through with its threats and filed a complaint against Invitae in this District
 5 alleging infringement of the '882 Patent on May 20, 2021 (*see* Case Number: 5:22-cv-03002-BLF).

6 **Defendant's Statement:**

7 Invitae filed the complaint ("Complaint") in this action on February 7, 2022. Invitae alleges
 8 that the accused product Gia does not infringe, directly or indirectly, any valid claim of the
 9 10,754,882 Patent (the '882 Patent or Patent-in-Suit).

10 OptraHealth understands that Invitae asserts the Gia product does not infringe the '882
 11 Patent. OptraHealth alleges that the Gia product infringes on at least claims 1 and 3 of the '882
 12 Patent by making, using, selling, offering for sale and/or importing the Gia accused product.

13 OptraHealth additionally alleges that Invitae induces infringement of the '882 patent by
 14 instructing, directing, and/or requiring others to perform all or some of the steps of method claims
 15 of the '882 Patent. OptraHealth further alleges that Invitae's infringement is willful. OptraHealth
 16 contends it holds all rights, title, and interest in the '882 Patent. OptraHealth seeks damages and
 17 injunctive relief for the alleged infringement, as well as a finding that this case is exceptional.

18 **3. LEGAL ISSUES**

19 The principal disputed legal issues are:

20 **Agreed:**

- 21 • The proper construction of any disputed claim terms
- 22 • Whether this case is an exceptional case (35 U.S.C. § 285)

23 **Plaintiff's Statement:**

- 24 • Whether Invitae has not infringed and is not infringing the Asserted Patent, either
 25 directly or indirectly.
- 26 • Whether OptraHealth and each of its officers, directors, agents, counsel, servants,
 27 employees, and all persons in active concert or participation with any of them, be
 28 restrained and enjoined from (i) alleging, representing, or otherwise stating that Invitae

1 or the manufacture, importation, use, offer for sale, or sale of the Accused Product
 2 infringes the Asserted Patent, and (ii) instituting or initiating any action or proceeding
 3 alleging infringement of the Asserted Patent against Invitae or customers,
 4 manufacturers, users, importers or sellers of the Accused Product.

- 5 • Whether Invitae states a claim upon which relief may be granted.
- 6 • Whether Invitae is entitled to an award of attorneys' fees pursuant to 35 U.S.C. § 285.

7 **Defendant's Statement:**

- 8 • The proper construction of any disputed claim terms;
- 9 • Whether Invitae infringes the Patent-in-Suit, either directly (35 U.S.C. § 271(a)) or
 10 indirectly (35 U.S.C. § 271(b));
- 11 • Any other affirmative defenses of Invitae;
- 12 • Whether OptraHealth is entitled to damages as a result of the alleged infringement
 13 of the Patent-in-Suit, and if so, the amount (35 U.S.C. § 284);
- 14 • Whether OptraHealth is entitled to injunctive relief to prevent alleged irreparable
 15 harm as a result of the alleged continuing infringement of the Patent-in-Suit (35 U.S.C. §
 16 283);
- 17 • Whether Invitae's alleged infringement is willful;

18 4. **MOTIONS**

19 (a) Pending Motions

20 There are currently no pending motions.

21 (b) Anticipated Motions

22 **Plaintiff's Statement:** Invitae anticipates moving to consolidate this action with the action
 23 that OptraHealth filed alleging infringement of the Asserted Patent (Case Number: 5:22-cv-03002-
 24 BLF). Invitae further anticipates moving for summary judgment and may file other dispositive and
 25 non-dispositive motions as appropriate, as the case progresses.

26 **Defendant's Statement:** OptraHealth anticipates moving for summary judgment and may
 27 file other dispositive and non-dispositive motions as appropriate, as the case progresses.

1 **5. AMENDMENT OF PLEADINGS**

2 N/A

3 **6. EVIDENCE PRESERVATION**

4 The parties have reviewed the Northern District of California's Guidelines for the
5 Discovery of Electronically Stored Information ("ESI") and Checklist for Rule 26(f) Meet and
6 Confer Regarding ESI, including those portions related to evidence preservation. Additionally,
7 the parties have not yet met and conferred regarding evidence preservation. Each party has
8 implemented a litigation hold with respect to all ESI and hardcopy documents and media
9 identified as relevant to this action. Further agreement regarding ESI preservation may be
10 addressed in the parties' Stipulated Order Regarding Discovery of ESI ("ESI Order").

11 **7. INITIAL DISCLOSURES**

12 The parties agree to exchange initial disclosures pursuant to Rule 26(a) 21 days after
13 discovery commences pursuant to Paragraph 8 below.

14 **8. DISCOVERY**

15 **Plaintiff's Statement:** No discovery has been taken to date in this action. The parties
16 should continue to meet and confer and shall submit and/or supplement this Joint Case Management
17 Statement with any modifications to the Patent Local Rules once this case is consolidated with
18 OptraHealth's action alleging infringement of the Asserted Patent (Case Number: 5:22-cv-03002-
19 BLF). This will allow the case to proceed most efficiently and also conserve judicial resources.

20 **Defendant's Statement:** No discovery has been taken to date. Pursuant to Rule 26(f) and
21 paragraph 8 of the Standing Order for All Judges of the Northern District of California – Contents
22 of Joint Case Management Statement, the parties propose no modifications need to be made to the
23 obligations or deadlines set forth in the Patent Local Rules.

24 **9. CLASS ACTIONS**

25 This case is not a class action.

26 **10. RELATED CASES**

27 *OptraHealth, Inc. v. Invitae Corporation* (Case Number: 5:22-cv-03002-BLF)

1 11. **RELIEF**

2 **Plaintiff's Statement:** Invitae seeks entry of a judgment (1) declaring that Invitae has not
 3 infringed, either directly or indirectly, any claims of the Asserted Patent and declaring that the
 4 manufacture, use, sale, offer for sale, and/or importation of the Accused Product does not infringe,
 5 directly or indirectly, any claims of the Asserted Patent; (2) that OptraHealth be restrained and
 6 enjoined from (i) alleging, representing, or otherwise stating that Invitae or the manufacture,
 7 importation, use, offer for sale, or sale of the Accused Product infringes the Asserted Patent, and
 8 (ii) instituting or initiating any action or proceeding alleging infringement of the Asserted Patent
 9 against Invitae or customers, manufacturers, users, importers or sellers of the Accused Product; (3)
 10 declaring that Invitae is the prevailing party and that this is an exceptional case and awarding Invitae
 11 is reasonable attorneys' fees, expenses, and costs; and (4) awarding Invitae its costs and reasonable
 12 expenses to the fullest extent permitted by law. OptraHealth has not asserted any counterclaims
 13 against Invitae.

14 **Defendant's Statement:** OptraHealth seeks entry of judgment finding that Invitae has
 15 infringed and is infringing the Patent-in-Suit. OptraHealth also seeks injunctive relief, including an
 16 injunction against Invitae from infringing the Patent-in-Suit. OptraHealth also seeks monetary
 17 damages, including damages based on a calculation of lost profits or an amount no less than a
 18 reasonable royalty. OptraHealth further seeks a finding that Invitae has willfully infringed the
 19 Patent-in-Suit and all damages-related remedies available to OptraHealth for Inviate's willful
 20 infringement. OptraHealth further seeks a judgment that this case is exceptional and an award of
 21 OptraHealth's costs and reasonable attorneys' fees. OptraHealth also seeks an accounting of all
 22 sales and revenues, together with pre-judgment and post-judgment interest.

23 12. **SETTLEMENT AND ADR**

24 Pursuant to ADR L.R. 3-5, the parties have reviewed the Court's ADR handbook, and will
 25 discuss the available ADR procedures and considered whether this case would benefit from an
 26 ADR procedure.

1 13. **CONSENT TO MAGISTRATE JUDGE FOR ALL PURPOSES**

2 Invitae consents to a magistrate judge conduct all further proceedings including trial and
3 entry of judgment.

4 OptraHealth declines to have a magistrate judge conduct all further proceedings including
5 trial and entry of judgment.

6 14. **OTHER REFERENCES**

7 The parties do not believe that this case is suitable for reference to binding arbitration, a
8 special master, or the Judicial Panel on Multidistrict Litigation.

9 15. **NARROWING OF ISSUES**

10 Subject to the progression of discovery, the parties may be able to narrow certain issues
11 via stipulated facts.

12 16. **EXPEDITED TRIAL PROCEDURE**

13 The parties do not propose that this case proceed under the Expedited Trial Procedure of
14 General Order 64 Attachment A.

15 17. **SCHEDULING**

16 The parties agree to jointly propose a scheduling order once discovery commences
17 pursuant to paragraph 8 above.

18 18. **TRIAL**

19 The parties have requested trial by jury. The parties expect that the trial will require
20 approximately 7-10 court days.

21 19. **DISCLOSURE OF NON-PARTY INTERESTED ENTITIES OR PERSONS**

22 Invitae is a publicly-held corporation that has no parent company and no other publicly-
23 traded corporation owns 10% or more of Invitae stock.

24 OptraHealth has filed a Certification of Interested Entities or Persons pursuant to Civil
25 Local Rule 3-16. OptraHealth certifies that other than the named parties, there is no such interest
26 to report.

1 20. **PROFESSIONAL CONDUCT**

2 The attorneys of record confirm that they have reviewed the Guidelines for Professional
3 Conduct for the Northern District of California.

4 21. **OTHER**

5 N/A

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1 Dated: June 14, 2022

2 Respectfully submitted,

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25 **THE ZHEN LAW FIRM**

26 By: /s/ Chris J. Zhen
27 Chris J. Zhen

28 *Attorney for Defendant OptraHealth*

ATTESTATION

In accordance with Civil Local Rule 5-1(i)(3), I attest that concurrence in the filing of this document has been obtained from any other signatory to this document.

By: /s/ K. Lee Marshall
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1
2 **CASE MANAGEMENT ORDER**
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6 The above JOINT CASE MANAGEMENT STATEMENT & PROPOSED ORDER is
7
8 approved as the Case Management Order for this case and the parties shall comply with its
9 provisions.
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11

12 **IT IS SO ORDERED.**
13
14

15 Dated: _____, 2022
16
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18 _____
19 HON. HAYWOOD S. GILLIAM, JR.
20 UNITED STATES DISTRICT JUDGE
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CERTIFICATE OF SERVICE

This is to certify that on the 14th day of June 2022, I electronically filed the foregoing JOINT CASE MANAGEMENT STATEMENT & PROPOSED ORDER using the Court's CM/ECF filing system which sends notification of such filing to all parties and/or counsel of record.

DATED: June 14, 2022

By: /s/ K. Lee Marshall

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